

DOCKET NO: 293048US2PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
YOHAN DESIERES, ET AL. : EXAMINER: SMYTH, A.P.
SERIAL NO: 10/585,073 :
FILED: JUNE 29, 2006 : GROUP ART UNIT: 2881
FOR: DIVERGENCE-CONTROLLED :
HYBRID MULTIPLE ELECTRON BEAM -
EMITTING DEVICE

RESTRICTION RESPONSE

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Restriction Requirement mailed June 10, 2009, Applicant elects, with traverse, the invention of group II, Claims 33-55. Applicant makes this election based on the understanding that Applicant is not prejudiced against filing one or more divisional applications that cover the non-elected claims.

The Restriction requirement indicates that the inventions of groups I and II are distinct. However, MPEP §806.05(j), cited as support for the present restriction, states that related product inventions are distinct if

A) the inventions as claimed do not overlap in scope, i.e., are mutually exclusive;

(B) the inventions as claimed are not obvious variants; and

(C) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect.

It is noted that all there requirements must be met for the restriction requirement to be proper. The invention of Claim 33 (group II) and the invention of Claim 56 (group I) overlap in scope because Claim 56 requires all the elements of Claim 33. Thus, the Restriction Requirement is incorrect is improper.

Moreover, MPEP § 803 states the following:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

It is believed that the claims of the present application would have to be searched in just two sub-classes. Since electronic searching is commonly performed, a search may be made of large number of, or theoretically all, subclasses without substantial additional effort.

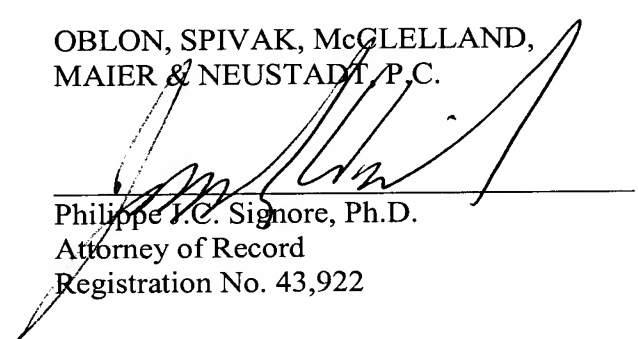
Furthermore, the contentions made in sub-paragraphs (d) and (e) on page 5 of the Office Action may arise in any situation where multiple claims are examined, and do not create a *serious* burden.

Accordingly, Applicant respectfully traverses the Restriction Requirement on the grounds that a search and examination of the entire application would not place a serious burden on the Examiner whereas it would be a serious burden on Applicant to prosecute and maintain separate applications, and the Office has not established a proper restriction requirement.

Consequently, it is respectfully requested that the requirement to elect a single invention be withdrawn and that a full examination be conducted for Claims 33-67.

Respectfully submitted,

OBLON, SPIVAK, MCGLELLAND,
MAIER & NEUSTADT, P.C.



Philippe J.C. Signore, Ph.D.
Attorney of Record
Registration No. 43,922

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)
1653138_1

Joseph Wrkich
Registration No. 53,796